

REMARKS

I. Double Patenting Rejection

Claims 17-37 stand rejected under the judicially-created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Pat. No. 6,327,354. A timely-filed terminal disclaimer is enclosed to overcome this rejection. For at least this reason, Applicants respectfully request that the rejection to claims 17-37 be withdrawn.

II. Rejection under 35 USC § 102

Claims 17-37 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,768,356 to McKendry et al. ("McKendry") or U.S. Pat. No. 5,875,240 to Silverman ("Silverman"). Applicants respectfully traverse the rejection. However, to expedite prosecution in the present application, claims have been amended to better define the invention.

McKendry discloses a personal call manager on a user's premises (Col. 4, lines 35-36). The personal call manager allows a home office user to improve accessibility when he is not able to answer one of his local extensions himself. Though the personal call manager includes a number of routing options based on the options specified by the user, the personal call manager also includes a menu selection option which allows a caller to direct his own call if the user does not answer one of his local extensions.

In this instance, if none of the local extensions originally dialed have answered, a menu call handler may give the caller the option to route the call (Col. 38, lines 7-13). Further, the personal call manager uses a maximum answer ring count and a maximum extension ring count in determining when to answer incoming telephone calls (Col. 39, lines 1-17). The personal call manager rings local extensions the number of times specified by the maximum answer ring count and only then answers the call to play a menu (Col. 39, lines 18-31).

Call mgr is server!
(1) Conversely, amended claims 17, 22, 27, 32, 33, and 34 recite "a server in a telephone network." The personal call manager of McKendry does not disclose or suggest a server located in the telephone network. In McKendry, the personal call manager picks up the call at the site of the user in order to allow a user with only a POTS telephone line to handle calls in a wide variety of ways (Col. 4, lines 35-36; Col. 8, lines 52-55). Thus, for at least these reasons, Applicants respectfully request that the rejection to claims 17, 22, 27, 32, 33, and 34 be withdrawn.

Further, amended claims 35-37 recite that "the first telephone call is placed to a third telephone number not corresponding to any of the plurality of destination options." As well, new dependent claim 38 recites that "the first telephone call is placed to a telephone number associated solely with the menu."

(2) The personal call manager of McKendry does not disclose or suggest a first telephone call to a telephone number not corresponding to the plurality of destination options. In McKendry, calls are placed initially to at least one destination option and only after a caller is unable to reach the user at a destination option does the personal call manager pick up the call. McKendry, therefore, only activates its menu handler after a telephone call has been placed to a telephone number associated with a telephone device on a business premises, connected to a local POTS line. Thus, for at least these reasons, Applicants respectfully request that the rejection to claims 35-37 be withdrawn and claim 38 be allowed.

(3) Further, McKendry does not disclose or suggest use of its device to reach multiple parties, particularly using the device in the context of a family. The Office Action contends that the McKendry system inherently allows routing of a call to a plurality of secondary locations. The MPEP notes that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" (MPEP §2112). "In relying upon the theory of inherency, the examiner must provide a

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basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (MPEP §2112, citing Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)). The McKendry system discloses use of its device to locate a single person in a business setting and does not disclose use of its device to reach a variety of people at a variety of destinations, such as members of a family at their residence or other locations. Therefore, even if the McKendry device might be capable of modification in order to reach members of a family, it does not **necessarily** perform this feature. Thus, for at least these reasons, Applicants respectfully request that the rejection to claims 17, 22, 27, 32, 33, 34, 35, 36, and 37 be withdrawn.

In addition, claims 18-21 and 38 depend from claim 17, directly or indirectly; claims 23-26 depend from claim 22, directly or indirectly; and claims 28-31 depend from claim 27, directly or indirectly. These dependent claims include all of the features of their respective independent claims, along with additional features. Therefore, for at least the reasons discussed above with respect to claims 17, 22, and 27, Applicants respectfully request that the rejections of claims 18-21, 23-26, and 28-31 be withdrawn and that claim 38 be allowed.

III. Statement of Substance of the Interview

Applicants thank the Examiner for the courtesy of an interview and for his comments and suggestions on the further prosecution of this application. The interview took place on November 26, 2003, between the Examiner, Creighton Smith, and the undersigned, Peter C. Breen, Reg. No. 47,441. The interview was via telephone, and no exhibits were shown or demonstrations conducted. The reference discussed was U.S. Pat. No. 5,768,356 to McKendry et al. Pending claim 17 was discussed. The Examiner recommended that Applicants review U.S.

Pat. No. 5,467,390 to Brankley, as well. The application of the cited reference to the claim was discussed, but agreement was not reached with respect to the claim.

IV. Conclusion

For all of the above reasons, Applicants respectfully request reconsideration and allowance of the present claims. The Examiner is invited to contact the undersigned attorney at (312) 222-8101 if there are any outstanding issues that could be resolved through a telephone conference.

Respectfully submitted,



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